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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,682	06/16/2005	Alexander Macasaet	30882/DP027	8592
4743 7590 10/15/2009 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606-6357			EXAMINER PERREAULT, ANDREW D	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 10/15/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,682	<b>Applicant(s)</b> MACASAET ET AL.	
	<b>Examiner</b> ANDREW PERREAULT	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-12, 15-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-12, 15-17, and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

It is noted that the claims as presented are directed to a product and method of forming the product. As currently presented, the method is the assembly of the product and its examination in conjunction with the product does not represent a serious burden at this time; therefore, no restriction is required. However, if subsequent amendments to the claims result in diverging subject matter and searches between the claimed inventions, the examiner reserves the right to restrict at that time.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/16/2009 has been entered.

Claims 1-3, 5-8, 10-12, 15-17, and 19-21 stand.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 5, 7, 8, 10, 15-17, and 19-21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi et al. (JP10059364) and Boersma (2003/0052038) in view of Mitsumori et al. (4,445,614).

Re claim 1, Hiroshi discloses a container (8; abstract; figs 1-6) including three sidewalls with corners therebetween (side walls in fig 6), the sidewalls defining an internal space (space within container for storage in fig s 1, 2) for storage of one item and a storage area, the shape of the storage area depending on the number of the sidewalls (the number of sidewalls determine the shape of the container in figs 1-6); the sidewalls being foldable about the corners for ease of storage (fig 6 shows the box being folded for storage); the sidewalls having an open base and an open top (fig 6 shows that there is no base or top so therefore the container is open); a pallet (1) with a planar and solid top (top of 1) onto which the sidewalls can be placed (fig 1-6); and a sidewall of the container having one perforated line(6, 9) to enable the height of the sidewall to be varied, wherein the one perforated line is parallel to an edge of the base for folding (abstract states that fold line 6 can be folded to vary the height of the sidewall; fig 2); but does not disclose that each side wall has a perforated line; the sidewalls and the pallet combine to form an open-top box; the top of the pallet forms a base for the sidewalls, the storage area being disposed immediately adjacent the planar top of the pallet, the open base of the sidewalls allowing at least one item to be placed directly on the pallet and within the storage area.

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Boersma discloses a similar device (10; figs 11, 12, 13) including four sidewalls (26) with corners there between, the sidewalls defining an internal space for storage of an item; the sidewalls being foldable about the corners (72, 176; fig 13) for ease of storage (fig 11, 12); the sidewalls having a base (19) and an open top (18); a pallet (14) with a planar and solid top onto which the sidewalls can be placed (fig. 11, 12); each sidewall of the container having a perforated line (70, 170, 172) to enable the height of the sidewalls to be varied, wherein the perforated line is parallel to an edge of the base for folding (fig 11, 12); the sidewalls and the pallet combine to form an open-top box (fig 11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Boersma, such each side wall has a perforated line; the sidewalls and the pallet combine to form an open-top box (fig 11), as suggested and taught by Boersma, for the purpose of improving the environment (Boersma paragraph 4) and for reducing volume of the container to allow the user to customize the device and its contents (Boersma paragraph 8). Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention duplicate the perforations on each side wall of Hiroshi in view of Boersma because it has been held that the duplication of parts on the basis of its suitability for the intended use was an obvious extension of the prior teaching. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)

Mitsumori discloses a similar device (figs 1-11) including that a top (top of P) of a pallet (P) forms a base for sidewalls ("seperable pallet forms the bottom of the box" abstract), a storage area (internal space within 5) being disposed immediately adjacent

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the planar top of the pallet, an open base of the sidewalls allowing at least one item to be placed directly on the pallet and within the storage area (the open base is capable of holding or performing the intended use of holding an item that directly contacts the pallet; “article ... placed on the pallet” col. 6, ll. 19-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Boersma, and further in view of Mitsumori, such each side wall has a perforated line; such that the top of the pallet forms a base for the sidewalls, the storage area being disposed immediately adjacent the planar top of the pallet, the open base of the sidewalls allowing at least one item to be placed directly on the pallet and within the storage area, as suggested and taught by Mitsumori, for the purpose of reducing the number of manufacturing steps, material, and cost col. 1, ll. 28-40). Furthermore, it would have been obvious to one of ordinary skill in the art to omit the base element of Hiroshi in view of Boersma, and further in view of Mitsumori, because omission of an element and its function is obvious if the function of the element is not desired, *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

Hiroshi in view of Boersma and Mitsumori discloses the claimed invention above for claim 1 with the exception of the following claimed limitations (in claims 2, 5, 17, and 10) that are further taught by Boersma:

Re claim 2, Boersma discloses wherein the sidewalls are made of a material selected of cardboard (page 4, claim 2).

Re claim 5, Boersma discloses that the sidewalls are foldable along the perforated line to vary the height of the sidewalls (fig 11, 12).

Re claim 17, Boersma discloses a cover (16; fig 1, 5) for the open top and the internal space.

Re claim 10, Boersma discloses wherein the cover is shaped to conform with the internal space defined by the sidewalls and comprises a cover top (90), and cover sides (92), the cover being adapted to be readily removable over the open top and locatable on an outer surface of the four sidewalls in the manner of a snug fit (paragraph 40). Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi in view of Boersma and Mitsumori (in claims 2, 5, 17, 10), and further in view of Boersma, for the same reasons as provided above in claim 1.

Re claim 7, Hiroshi discloses that the top (top of 1) being of a length and width slightly greater than the corresponding dimensions of the sidewalls (figs 1-4 show that the top of pallet is wider and longer than the sidewalls of the container 8).

Re claim 8, Hiroshi discloses that a gap is formed between an outer edge of the four sidewalls and a peripheral edge of the top of the pallet (since stated in claim 7 that figs 1-4 show that the top of pallet is wider and longer than the sidewalls of the container 8, a gap exists between the edge of pallet and the edge of the sidewalls).

Re claims 15 and 16, Hiroshi in view of Boersma and Mitsumori discloses the claimed invention above for claims 7 and 8 with the exception of the following claimed limitations that are further taught by Mitsumori: the top of the pallet forms a solid base

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for the sidewalls ("seperable pallet forms the bottom of the box" abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi in view of Boersma and Mitsumori, and further in view of Mitsumori, for the same reasons as provided above in claim 1.

Re claim 19, Hiroshi in view of Boersma and Mitsumori discloses a single standardized container (Boersma 10; Hiroshi figs 1-6; Mitsumori figs 1-11) that may be customized to meet the needs of different load and height requirements of objects to be stored and transported comprising the container (the references are able to perform to the intended use of being of able to be customized to meet the needs of the user). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 20, Hiroshi discloses that the storage area has a rectangular shape (figs 1-6).

Re claim 21, as discussed above, Hiroshi in view of Boersma and Mitsumori discloses the product as claimed. To the extent that the claimed product performs the claimed method, the prior art product performs the method steps, as claimed.

2. Claims 3, 11, and 12 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the Hiroshi in view of Boersma and Mitsumori as applied to claims 1 and 2 above, and further in view of applicant's admitted prior art (with reference to



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claims 3, 11, and 12 in office action 10/24/08, applicant has not challenged the examiner's official notice; therefore, the official notice is now considered admitted prior art. See MPEP 2144.03).

Re claims 3, 11, and 12, the combined references do not disclose wherein the material is weather-resistant and the pallet material type. However, applicant's admitted prior art discloses wherein the material is weather-resistant and the pallet material type. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, including wherein the material is weather-resistant, as suggested and taught by applicant's admitted prior art, for the purpose of protecting the device from damage. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the material of Hiroshi in view of Boersma and Mitsumori because it has been held that selection of a known material on the basis of its suitability for the intended use was an obvious extension of the prior teaching. *In re Leshin*, 125 USPQ 416.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi in view of Boersma and Mitsumori as applied to claim 1 above, and further in view of Rose (6,119,929).

Re claim 6, Hiroshi in view of Boersma and Mitsumori does not specifically disclose that the sidewalls are shearable along the perforated line to vary the height of the sidewalls. However, Rose discloses a similar container (40; fig 4) with sidewalls (26, 28) and a perforated line (32); wherein the sidewalls are shearable ("a means for

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permitting the tearing” col. 15, line 8-32) along the perforated line to vary the height of the sidewalls. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Boersma and Mitsumori, and further in view of Rose, such that the sidewalls are shearable along the perforated, as suggested and taught by Rose, for the purpose of providing “a container having a plurality of selectable volumes” (col. 6, ll. 35-40).

4. Claims 3, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi in view of Boersma and Mitsumori as applied to claim 1 above, and further in view of Barnes et al. (3,968,895).

As to claims 3 and 11-12, Hiroshi in view of Boersma and Mitsumori does not disclose that the sidewalls are made of a plastic weather-resistant material or that the pallet is formed of a plastic weather-resistant material. However, Barnes et al. teaches a similar container 1 (fig. 1) including four sidewalls 11a-11c, 15, a cover 37, and a pallet 3 (fig. 1) wherein the sidewalls 11a-11c, 15 are made of a material consisting of plastics (col. 5, lines 30-41), wherein the material is weather-resistant (col. 5, lines 30-41); and the pallet 3 is formed of a material of plastics (col. 5, lines 30-41), wherein the material is weather resistant (col. 5, lines 30-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Boersma and Mitsumori, such that the sidewalls and pallets are made of a plastic weather-resistant material, as suggested and taught by Barnes et al., in order for the container to be reused by being capable of withstanding damage from

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rough transporting conditions such as inclement weather and chemicals (col. 5, lines 30-41).

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW PERREAULT whose telephone number is

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(571)270-5427. The examiner can normally be reached on Monday - Friday, 8:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (571)272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P./  
Examiner, Art Unit 3728

/Ehud Gartenberg/

Supervisory Patent Examiner, Art Unit 3728